REMARKS

The Final Office Action of February 23, 2005, has been received and reviewed. Claims 2, 4, 6, 8, 9, 11-16, 18, 23-31, 34 and 36-39 are pending in the application. Claims 2, 4, 6, 8, 9, 12, 24-31 and 39 are allowed, and claims 11, 13-16, 18, 23, 34 and 36-38 stand rejected. The applicants filed an amendment on February 17, 2005, before the issuance of the Final Office Action of February 23, 2005. Thus, the remarks presented herein are made in view the amendments to the claims and the addition of new claim 40 filed February 17, 2005. Applicants propose to amend claims 36 and 37 as set forth herein. In view of the amendments and remarks presented herein, reconsideration is requested.

Rejections under 35 U.S.C. § 102

Claims 11, 13-16, 18, 23, 34 and 36 stand rejected under 35 U.S.C. § 102(e) as assertedly being anticipated by Lassner et al. for the reasons set forth in the official action mailed 7/1/2004. Applicants respectfully traverse the rejections as set forth herein.

Claim 11 is directed towards a plant seed having a genome, wherein said genome comprises an introduced nucleotide sequence of SEQ ID NO: 1 or SEQ ID NO: 3 encoding a polypeptide having diacylglycerol acyltransferase activity. Lassner et al. does not disclose a plant seed having a genome comprising an introduced sequence of SEQ NO: 1 or SEQ ID NO: 3 and, thus, cannot anticipate claim 11.

Claim 13 is directed towards a genetically transformed plant seed, wherein the genome of the plant seed has been transformed by means for encoding a polypeptide having diacylglycerol acyltransferase activity. The applicants respectfully submit that the Office is not properly construing the means plus function language. The MPEP states that the "USPTO must apply 35 U.S.C. § 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation in light of and consistent with the written description of the invention in the application." (M.P.E.P. § 2181, *citing In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (emphasis added)). The as-filed specification discloses a written description means for encoding a polypeptide having diacylglycerol acyltransferase activity at page 4, lines 1-3. Since Lassner et al. does not disclose the means for encoding a polypeptide having diacylglycerol acyltransferase activity as described in the as-filed specification, claim 13 cannot be anticipated.

Claim 23 cannot be anticipated since Lassner et al. does not disclose a method of changing the oil content, acyl composition or diacylglycerol/triacylglycerol ratio of the seed oil of plant seeds comprising, *inter alia*, introducing a nucleic acid construct comprising a nucleic acid sequence encoding a polypeptide having diacylglycerol acyltransferase activity into a plant transformation vector; transforming the genome of a plant or plant seed with said plant transformation vector; and selecting the transformed plant or plant seed having the changed oil content, acyl composition or diacylglycerol/triacylglycerol ratio as compared to an average of a statistically-significant number of seeds of plants of the same genotype grown in identical conditions, but without the introduced nucleotide sequence.

The rejection of record asserted hat because the method steps of Lassner et al. and applicants are the same, that it would be an inherent property of the DNA molecule of Lassner et al. to alter said seed oil content, diacylglycerol content, fatty acyl composition or enhance biomass. (*See*, Office Action of July 12, 2004, page 3). However, in order to establish anticipation, the cited reference needs to enable the subject matter that falls within the scope of the claims. (*See, Schering Corp. v. Geneva Pharmaceuticals Inc.*, 67 USPQ2d 1664, 1670 (Fed. Cir. 2003)).

As established by Dr. Taylor in his Declaration under 1.132 (of record), "U.S. Patent 6,444,876 does not disclose any working examples of the plant seed having the nucleotide sequence encoding the polypeptide having diacylglycerol acyltransferase activity, wherein the sequence of the polypeptide comprises SEQ ID NO: 2. In fact, U.S. Patent 6,444,876 does not disclose any working examples of any transformed plant seeds." The declaration is substantial evidence that the specification of Lassner et al. does not disclose or enable any working examples of a plant seed having the nucleotide sequence encoding the polypeptide having diacylglycerol acyltransferase activity. (*See, In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)). Thus, since Lassner et al. does not disclose or enable any working examples of a plant seed having the nucleotide sequence encoding the polypeptide having diacylglycerol acyltransferase activity, Lassner et al. also cannot disclose or enable selecting for a transformed plant or plant seed having the changed oil content, acyl composition or diacylglycerol/triacylglycerol ratio as recited in claim 23.

Further, since the claims of U.S. Patent 6,444,876 do not disclose selection, there is no presumption that Lassner et al. enables a method that includes selecting for a transformed plant or plant seed having the changed oil content, acyl composition or diacylglycerol/triacylglycerol ratio as recited in claim 23. Thus, Lassner et al. cannot anticipate claim 23.

Amended claim 36 cannot be anticipated since Lassner et al. does not disclose a transgenic plant cell comprising a genome and means for encoding a polypeptide having diacylglycerol acyltransferase activity integrated in the genome. As previously established herein, Lassner et al. does not disclose the means for encoding a polypeptide having diacylglycerol acyltransferase activity as described at page 4, lines 1-3 of the as-filed specification.

Dependent claims 14-16, 18 and 34 depend from and, thus, include the elements of independent claim 11 which is not anticipated by Lassner et al. Thus, dependent claims 14-16, 18 and 34 are also not anticipated by Lassner et al.

Reconsideration and withdrawal of the anticipation rejections of claims 11, 13-16, 18, 23, 34 and 36 are requested.

Rejections under 35 U.S.C. § 101

Claims 36-38 stand rejected under 35 U.S.C. § 101 as assertedly being directed to non-statutory subject matter. Claim 38 has been canceled rendering the rejection thereof moot. Applicants respectfully traverse the remaining rejections as set forth herein

It was thought that because independent claim 36 is directed towards a plant cell comprising a means for encoding a polypeptide having diacylglycerol acyltransferase activity, that the "hand of man" was not involved in the invention. (*See*, Final Office Action, page 3). Although applicants do not agree with the rejection, to expedite prosecution, applicants propose to amend claims 36 and 37 to recite "transgenic plant seed" rather than "plant seed" to indicate that the "hand of man" is involved.

Reconsideration and withdrawal of 35 U.S.C. § 101 rejections of claims 36 and 37 are requested.

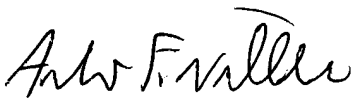
ENTRY OF AMENDMENTS

The proposed amendments to claims 36 and 37 should be entered by the Examiner since they are supported by the as-filed specification, do not add any new matter and should not require a further search. For instance, the element of "transgenic" added to claims 36 and 37 is present in pending claim 12. Further, the proposed amendments should place the application in condition for allowance. Should the Examiner determine that the proposed amendments do not place the application in condition for allowance, entry is requested since it will simplify issues for appeal.

CONCLUSION

In view of the proposed amendments and remarks, the applicants submit that the claims define patentable subject matter and a notice of allowance is requested. Should questions exist after consideration of the foregoing, the Office is kindly requested to contact the applicants' attorney at the address or telephone number given herein.

Respectfully submitted,



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Date: April 25, 2005
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